THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. NOONE and WILLIAM C. WOELLNER

Appeal No. 1999-0705
Application No. 08/129,615

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, NASE and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 6, 13-17, 19, 22-26, 28-30, 32, 33 and 35, which are all of the claims pending in this application. Claims 22 and 35 were amended after the final rejection (see Paper No. 21, filed March 23, 1998). This amendment has been entered, pursuant to the examiner's advisory action (Paper No. 22).

BACKGROUND

The appellants' invention relates to a one-piece roofing tile, preferably formed of molded clay material, so as to simulate a natural appearing tile, with the tile having hollowed zones or recesses for weight reduction, and strengthening webs to provide support for the tile in the installed, on-roof condition (specification, page 2), a method of roofing a roof using such tiles and a roof covered with such tiles. The claims on appeal are reproduced in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Donaldson et al. (Donaldson)	522,686	Jul. 10, 1894
O'Donnell	D 281,536	Nov. 26, 1985
Matthews (German patent publication)	1,708,994	Jan. 18, 1979[1]
Cole (Australian patent specification)	224,414	Jun. 12, 1958

The following rejections are before us for review.

1. Claims 1, 6, 15, 16, 25, 26, 28-30, 32, 33 and 35 stand rejected under 35 U.S.C. § 103 as being unpatentable over Matthews in view of Donaldson.

[1] We derive our understanding of this reference from the English language translation prepared for the PTO and attached to Paper No. 18.

2. Claims 13 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Matthews in view of Donaldson, as applied above, and further in view of O'Donnell.

3. Claims 17, 19 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Matthews in view of Donaldson, as applied to claims 1, 6, 15, 16, 25, 26, 28-30, 32, 33 and 35 above, and further in view of Cole.

4. Claims 23 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Matthews in view of Donaldson and Cole, as applied to claims 17, 19 and 22 above, and further in view of O'Donnell.

Reference is made to the brief (Paper No. 25) and the answer (Paper No. 26) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Independent claim 1 requires, inter alia, a pair of generally spaced apart webs, "meeting in a common line, forming a generally inverted, smoothly contoured and curved, U-shaped groove tile cut line therebetween." Similarly, independent claims 15, 17, 25, 29, 30 and 35

require "web sides meeting in a common line forming a generally inverted, smoothly contoured and curved, U-shaped groove tile cut line.[2]" This feature of the claims is best illustrated in the appellants' Figure 4, wherein the adjacent sides of parallel webs (63, 64) are shown converging toward one another to a juncture where they form a common cut line (90 - shown in Figure 2), at the bottom surface of the tile, through which a tile cut plane may pass (see appellants' specification, page 8).

Matthews, the primary reference relied upon by the examiner in rejecting the claims, discloses a roof tile having, on the bottom surface thereof, a plurality of ribs (30, 31, 32, 33) spaced between recesses (25, 26, 27, 28, 29). The examiner takes the position that the webs (ribs 31, 32), or sides thereof, "converge to a common line at (27) in the claimed inverted, smoothly contoured and curved, U-shaped manner" (answer, page 5). While it may be true that the recess (27) formed between the ribs (31, 32) of Matthews is a "generally inverted, smoothly contoured and curved, U-shaped groove" as recited in the claims, the ribs (31, 32), or sides thereof cannot reasonably be construed as "meeting in a common line" as also called for in independent claims 1, 15, 17, 25, 29, 30 and 35. As best seen in Figures 7 and 8 of Matthews, the sides of the ribs (31, 32) each extend from the peak of the rib to the base of the recess (27). However, the adjacent sides of the ribs meet the base of the recess at locations which are spaced from one another such that the webs do not meet in a common line.

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[2] Claim 35 omits "a" before "generally".

Moreover, we have reviewed the teachings of Donaldson but we find nothing therein which overcomes the deficiency of Matthews discussed above. Therefore, it is our opinion that the combined teachings of Matthews and Donaldson are not sufficient to have rendered the subject matter of independent claims 1, 15, 25, 29, 30 and 35 obvious within the meaning of 35 U.S.C. § 103.[3]

For the foregoing reasons, we shall not sustain the examiner's rejection of independent claims 1, 15, 25, 29, 30 and 35, or of claims 6, 16, 26, 28 and 32 which depend therefrom, under 35 U.S.C. § 103 as being unpatentable over Matthews in view of Donaldson.

As to independent claim 17, which, as discussed above, also recites "web sides meeting in a common line forming a generally inverted, smoothly contoured and curved, U-shaped groove tile cut line," we have reviewed the teachings of Cole but find nothing therein which overcomes the above-noted deficiency of the combination of Matthews and Donaldson. Therefore, we also shall not sustain the examiner's rejection of claim 17, or claims 19 and 22 which depend therefrom, under 35 U.S.C. § 103 as being unpatentable over Matthews in view of Donaldson and Cole.

We have also reviewed the teachings of O'Donnell but find nothing therein which overcomes the above-noted deficiency of the combination of Matthews and Donaldson or

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[3] The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Matthews, Donaldson and Cole. It follows then that we also shall not sustain the examiner's 35 U.S.C. § 103 rejections of claims 13 and 14, which depend from claim 1, as being unpatentable over Matthews in view of Donaldson and O'Donnell and claims 23 and 24, which depend from claim 17, as being unpatentable over Matthews in view of Donaldson, Cole and O'Donnell.

Turning finally to claim 33, however, for the reasons discussed below in the new ground of rejection, we conclude that the claim language fails to particularly point out and distinctly claim the subject matter which the appellants regard as the invention as required by the second paragraph of 35 U.S.C. § 112. While we might speculate as to what is meant by the claim language, our uncertainty provides us with no proper basis for making the comparison between that which is claimed and the prior art as we are obliged to do. Rejections under 35 U.S.C. § 103 should not be based upon "considerable speculation as to the meaning of the terms employed and assumptions as to the scope of the claims." In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Accordingly, we are constrained to reverse, pro forma, the examiner's rejection of claim 33 under 35 U.S.C. § 103. We hasten to add that this is a procedural reversal rather than one based upon the merits of the 35 U.S.C. § 103 rejection.

NEW GROUND OF REJECTION

Pursuant to the provisions of 37 CFR § 1.196(b), we make the following new ground of rejection.

Claim 33 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention. In particular, we note the recitation of

> generally parallel webs having adjacent converging web **sides** that converge toward said top of said tile in a generally inverted, smoothly contoured and curved, U-shaped configuration, said **walls** of said **web** meeting in a common line forming a tile cut line therebetween [emphasis added] . . .

Initially, "said walls of said web" lack clear antecedent basis in the claim. While it appears that the appellants may have inadvertently used the term "walls" instead of "sides," the claim does not provide any basis upon which one of ordinary skill in the art could ascertain with any reasonable degree of certainty whether "walls" refers back to "sides" or whether "walls" are another distinct element of the web. Moreover, as the claim recites plural "webs," it is not clear whether "said web" refers to one of the recited "webs" or is merely a misspelling of "webs." Consequently, it is not clear whether the claim requires walls of more than one web to meet in a common line or whether two sides (e.g., the left and right sides, respectively) of one of the webs meeting in a common line (at the apex of the web) would satisfy the claim limitation "said walls of said web meeting in a common line forming a tile cut line therebetween."

Accordingly, it is our opinion that claim 33 fails to define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity so as to satisfy the requirements of the second paragraph of 35 U.S.C. § 112.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 6, 13-17, 19, 22-26, 28-30, 32, 33 and 35 under 35 U.S.C. § 103 is reversed. Additionally, a new ground of rejection of claim 33 is added pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

HARRISON E. McCANDLISH Senior Administrative Patent Judge	)
JEFFREY V. NASE Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)

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